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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,872	12/28/1999	KYONGGEUN YOON	JEFF-Y0001	1565

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EXAMINER

WOITACH, JOSEPH T

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 01/17/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/473,872

Applicant(s)
Yoon, K.

Examiner
Joseph Weitach

Art Unit
1632



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jan 7, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-40

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____

Deborah Crouch
DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1800/1600

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Sections 2(a)(b) and (c):

The amendment to claims 1, 18 and 40 of 'lasting beyond the natural life span of differentiated epidermal cells' does not have literal support at the portions of the specification indicated by Applicants. Further, given the generalities of the delivery method and discussion for the cells which are affected by the method, it does not appear that the specification supports this specific limitation, and thus, would be considered new matter. Further, the limitation of 'a natural life span' of epidermal cells is not described or defined in the specification and raises issues under 35 U.S.C. 112, second paragraph. With respect to the proposed amendments to claim 32, while this limitation is not specifically set forth in the specification, it would be clear to an artisan that delivery of an RDO to a skin cell would not result in germline transmission. However, this new embodiment has not been previously considered and would require a new search of the relevant art for animal models in which only a portion of the skin is affected.

Section 5:

With respect to the rejection made under 35 U.S.C. 112, second paragraph, Applicants argue that claims 1 and 18 clearly set forth functional limitation wherein one would know the metes and bounds of the claims. This is not found persuasive because there is no clear connection between a double hairpin structure and any specific characteristic of said structure. Neither is there is connection for being able to affect any genetic alteration is a selected gene or

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affecting any specific phenotype for any period of time. A consequence of practicing a method fails to clearly define the metes and bounds encompassed by a simple hairpin loop structure.

Arguments in traverse of the art rejections have not been considered because they are directed to claims embodiments which have not been entered.